



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,328	09/10/2003	Paul Spaeth	16222U-011310US	5961
66/945 7590 07/02/2010 TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER				
RETTA, YIHDEGA				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
07/02/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,328

Applicant(s)

SPAETH ET AL.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-7, 9-20, 35-43, 45, 46, 48-51 and 55-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 9-20, 35-43, 45, 46, 48-51, 55-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in amendment filed March 24, 2010. Applicant amended claims 1, 13, 35, 39, 43, 46, 59 and canceled claim 53. Claims 1, 4-7, 9-20, 35-43, 45, 46, 48-51, 55-63 are currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35-43, 45, are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al. (US 6,298,336).

Regarding claims 35-39, Davis teaches *means for* receiving a request *using a keypad or graphical user interface* for changing the participation status from a first status to a second status; *means for* receiving card image data from the portable device, the card image data including a parameter indicating the participation status as having the first status for the portable device; *means for* modifying the parameter in the card image; *means for* updating the card image data in the portable device; *means for* establishing a connection with the portable device to allow the card image data to be received *means for* sending an indication to a host indicating that the parameter in the portable device was modified (see col. 3 lines 24-45, col. 14 line 18 to col. 15 line 2, col. 16 line 17 to col. 17 line 48). The means of receiving the request does not change whether the change is from a first status to a second status or from second status to a first status.

There is no difference from changing, for example, 1 to 0 or 0 to 1 since there is no additional manipulation during the change. No patentable weight is given to the content of the information which is being handled by the system. The content of the information is based on nonfunctional descriptive material which cannot distinguish the invention from the prior art. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994).

Regarding claims 43, 45 and 49, Davis teaches providing a parameter in the portable device, the parameter indicating the status of the portable device for the loyalty program; providing card image data, the card image data including the parameter and providing a modifying mechanism to modify the parameter in the portable device in response to a request by a loyalty plan participant via a keypad associated with an acceptance point device (see fig. 2, 3 & 8A) the modification of the parameter corresponding to a change of the participation status in the loyalty program from a first status to a second status for the portable device; wherein modification occurs at the acceptance point device; wherein the portable device comprises at least one of a smartcard, a cellular phone, a personal digital assistant (PDA), a pager, a payment card, a security card, an access card, smart media and a transponder; wherein the acceptance point device includes a point-of-sale device (see col. 3 lines 24-45, col. 14 line 18 to col. 15 line 2, col. 16 line 17 to col. 17 line 48).

Regarding claims 59-63, Davis teaches means for sending card image data from the portable device to an acceptance point device, the card image data including a parameter indicating the participation status as having a first status, wherein the parameter in the card image data is subsequently modified by the acceptance point device, the modification of the parameter

corresponding to a change of the participation status from the first status to a second status; and means for receiving the card image data with the modified parameter, the modified parameter indicating the participation status as having the second status (see col. 3 lines 24-45, col. 14 line 18 to col. 15 line 2, col. 16 line 17 to col. 17 line 48); wherein the portable device comprises at least one of a smartcard, a cellular phone, a personal digital assistant (PDA), a payment card, a pager, a security card, an access card, smart media and a transponder; wherein the card image data is sent to a computing device connected to the Internet (see fig. 1, col. 3 lines 24-44, and col. 16 lines 17-48); wherein the computing device is configured to communicate with the portable device; wherein the computing device comprises means for modifying the parameter in the card image data; wherein the computing device comprises at least one of an acceptance point device, a personal computer (PC), a workstation, a personal digital assistant (PDA), a cellular phone, a set-top box, a kiosk, and a tablet PC (see col. 16 lines 18-48).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-7, 9-20, 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (US 6,298,336) and further in view of Smith et al. 5,777,305.

Regarding claims 1, 56, Davis teaches receiving, by an acceptance point device, an indication from the loyalty program participant *using a keypad associated with the acceptance*

point device, to change the participation status in the loyalty program from a first status to a second status; receiving, *at the acceptance point device*, card image data from the portable device, the card image data including a parameter having a first value, the first value indicating the participation status as having the first status; modifying, *by the acceptance point device*, the parameter in the card image data from the first value to a second value; and sending, *by the acceptance point device*, the card image data with the modified parameter to the portable device; wherein the acceptance point device comprises at least one of a point of sale device, a cellular phone, a personal digital assistant, a hand-held specialized reader, a cellular phone, a set-top box, a kiosk, a personal computer, a table PC, an electronic cash register, a virtual cash register, a security system, and an access system (see col. 3 lines 24-45, col. 14 line 18 to col. 15 line 216, col. 16 line 17 to col. 17 line 48).

Davis does not teach the receiving to change the status is after the card is activated. Smith teaches receiving a request to deactivate a card after being activated. Smith teaches deactivating an activated card using the same step as activating the card if the card is to be returned or be reused (see col. 7 line 45 to col. 8 line 30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow a request to deactivate Davis's card by performing the same step performed during activation, in order to return the card to inactive status, as taught in Smith (see abstract and col. 2 line 65 to col. 3 line 4).

Regarding claims 4-7 and 10-12, Davis as modified teaches sending an indication that the parameter in the portable device was modified from a first value to a second value to a host; further comprising changing a record for the status of the portable device to the second status at the host; wherein if the first status is an active status, the second status is an inactive status, and

wherein if the first status is an inactive status, the second status is an active status; wherein the indication to change the participation status is received at an acceptance point device; and wherein the acceptance point device is configured to communicate with the portable device; wherein the indication to change the participation status is provided by the loyalty program participant or a host managing the loyalty program; teaches wherein the participation status includes one of a plurality of levels, which includes an account level, a card level, a program level and a transaction level (see col. 2 lines 24-45, col. 10 lines 9-66).

Regarding claim 9, Davis as modified teaches therein the indication to change the participation status is received at a computing device connected to the Internet (see fig. 9 and col. 16 lines 18-48)

Regarding claims 13-20, Davis teaches receiving, *by an Internet system*, an indication from the loyalty program participant using a keypad associated with the acceptance point device, to change the participation status in the loyalty program from a first status to a second status; receiving, *at the Internet system*, card image data from the portable device, the card image data including a parameter having a first value, the first value indicating the participation status as having the first status; modifying, *using the Internet system*, the parameter in the card image data from the first value to a second value; and sending, by the acceptance point device, the card image data with the modified parameter to the portable device (see col. 3 lines 24-45, col. 14 line 18 to col. 15 line 2, col. 16 line 17 to col. 17 line 48).

Davis does not teach the receiving to change the status is after the card is activated. Smith teaches receiving a request to deactivate a card after being activated. Smith teaches deactivating an activated card using the same step as activating the card if the card is to be returned or be

reused (see col. 7 line 45 to col. 8 line 30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow a request to deactivate Davis's card by performing the same step performed during activation, in order to return the card to inactive status, as taught in Smith (see abstract and col. 2 line 65 to col. 3 line 4).

Regarding claims 57-58, Davis teaches wherein if the first status is an active status, then the second status is an inactive status, and if the first status is an inactive status, then the second status is an active status returning an error message to the portable device if the first status is an inactive status and the second status is an inactive status (see col. 14 lines 18-52).

Claims 39-42, 46, 48-51, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiRaimondo et al. (US 7,032,047) in view of Davis et al. (US 6,298,336).

Regarding claim 39, DiRaimondo teaches a network computing device configured to communicate with the portable device the networked device comprising (card reader interface); means for establishing a connection with the portable device; *means for* receiving a request from the loyalty program participant for changing the participation status from a first status to a second status; *means for* receiving card image data from the portable device, the card image data including a parameter indicating the participation status as having the first status (see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45); a loyalty server module component configured to communicate with the networked computing device and receive the sent card image data, wherein the loyalty server module comprises : *means for* modifying the parameter in the card image data, the modification of the parameter corresponding to a change of the participation status from the first status to the second status; and *means for* sending the modified card image

data to the networked computing device, wherein the networked computing device further comprises *means for* updating the card image data in the portable device with the modified card image data, the modified parameter indicating the participation status as having the second status (col. 10 line 33 to col. 11 line 33).

DiRaimondo does not teach means for receiving a request using a keypad or a graphical user interface for changing the participation status, it is taught in Davis (see col. 16 lines 17-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide means of receiving a request using a keypad or graphical user interface as in Davis in order to provide the participants of DiRaimondo a convenient means of changing the status of the card.

Regarding claims 40-42, DiRaimondo teaches *means for* communicating through a network to establish a connection with the loyalty server module (see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45); *means for* receiving a transaction ID from the loyalty server module; *means for* using the transaction ID to connect to the loyalty server module through the network (see col. 5 lines 34-67, col. 9 line 20 to col. 10 line 31); teaches wherein the participation status includes one of a plurality of levels, which includes an account level, a card level, a program level and a transaction level (see col. 4 lines 6-56).

Regarding claim 46, DiRaimondo teaches a portable device configured to include card image data, the card image data including information relating to the loyalty program participant and a parameter that corresponds to a participation status, the participation status having a first status or a second status and representing whether participation in the loyalty program is active or

inactive; and a computing device configured to: receive an indication from the loyalty program participant to change the participation status from the first status to the second status, modify the card image data including the parameter, and update the portable device with the modified card image data; wherein the computing device is further configured to modify the card image data by retrieving the card image data from the portable device and modifying the retrieved card image data; and wherein the computing device is further configured to update the portable device by uploading the modified card image data to the portable device and replacing the card image data on the portable device with the modified card data image (see fig. 1-2C, col. 6 line 55 to col. 7 line 17, col. 11 lines 4-45).

DiRaimondo does not teach in response to a request via a keypad associated with an acceptance point device, it is taught in Davis (see col. 16 lines 17-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide means of receiving a request using a keypad or graphical user interface as in Davis in order to provide the participants of DiRaimondo a convenient means of changing the status of the card.

Regarding claims 48-51 and 55, DiRaimondo teaches a portable device wherein the computing device comprises at least one of an acceptance point device, a personal computer (PC), a workstation, a personal digital assistant (PDA), a cellular phone, a set-top box, a kiosk, and a tablet PC; wherein the acceptance point device includes a point-of-sale device; wherein the portable device comprises at least one of a smartcard, a cellular phone, a personal digital assistant (PDA), a payment card, a pager, a security card, an access card, smart media and a transponder; wherein the computing device is further configured to send an indication to a host indicating that the parameter in the portable device has been modified; wherein the indication to

change the participation status from the first status to the second status is received from the loyalty program participant; wherein the indication to change the participation status from the first status to the second status is received from a host managing the loyalty program; wherein if the first status is an active status, then the second status is an inactive status, and if the first status is an inactive status, then the second status is an active status (see fig. 1-2C, col. 6 line 55 to col. 7 line 17, col. 11 lines 4-45).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-7, 9-12 and 13-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8-11 of U.S. Patent No. 7,121,456. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

The current application does not include examining an update indicator on the portable (token) device to determine whether a current token image on the portable token is to be updated, as recited in claim 8 of US 7,121,456. However it would have been obvious to one of ordinary skill in the art at the time of the invention to examine or determine before sending a message to change the status of the device in order to verify whether the device can be updated or changed.

Claims 39-42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 7,121,456. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

The current application does not include examining an update indicator on the portable (token) device to determine whether a current token image on the portable token is to be updated, as recited in claim 1 or 6 of US 7,121,456. However it would have been obvious to one of

ordinary skill in the art at the time of the invention to examine or determine before sending a message to change the status of the device in order to verify whether the device can be updated or changed.

Claims 1, 4-7 and 9-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,374,078. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

Claim 1 of the current application recites receiving an indication to change the an image (card image data) using a keypad associated with the acceptance point device, which is not claimed in the 7,374,078. However it would have been obvious to one of ordinary skill in the art at the time of the invention to use a keypad to request the change in order to provide the information in a most convenient way.

Claims 35-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-17 of U.S. Patent No. 7,374,078. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

Claim 35 of the current application recites means for receiving an indication to change the an image (card image data) using a keypad associated with the acceptance point device, which is not claimed in the 7,374,078. However it would have been obvious to one of ordinary skill in the art at the time of the invention to use a keypad to request the change in order to provide the information in a most convenient way.

Claims 1, 4-7, 9-12 and 13-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 7,591,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

The current application does not include wherein the acceptance point device reads an update indicator on the portable device, as recited in claim 1 of US 7,591,412. However it would have been obvious to one of ordinary skill in the art at the time of the invention to read or determine update indicator before sending a message to change the status of the device in order to verify whether the device can be updated or changed.

Claims 43, 45 and 59-63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-17 of U.S. Patent No. 7,591,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

The current application does not include wherein the portable device (phone) comprises of update indicator, as recited in claim 11 of US 7,591,412. However it would have been obvious to one of ordinary skill in the art at the time of the invention for a portable device to include an indicator so that only portable devices with an update indicators can be updated or changed.

Claims 1, 4-7, 9-12 and 13-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,624,917. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

The current application does not include wherein the acceptance point device reads an update indicator on the portable device, as recited in claim 1 of US 7,624,917. However it would have been obvious to one of ordinary skill in the art at the time of the invention to read or determine update indicator before sending a message to change the status of the device in order to verify whether the device can be updated or changed.

Claims 39-42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-17 of U.S. Patent No. 7,624,917. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

Claims 46, 48-51, 55-58 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-22 of U.S. Patent No. 7,624,917. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

The current application does not include wherein the acceptance point device reads an update indicator on the portable device, as recited in claim 1 of US 7,624,917. However it would have been obvious to one of ordinary skill in the art at the time of the invention to read or determine update indicator before sending a message to change the status of the device in order to verify whether the device can be updated or changed.

Claims 39-42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-17 of U.S. Patent No. 7,624,917. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

Claims 1, 4-7, 9-12 and 13-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-34 of copending Application No. 11,923,958. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other. For example claim 1 of the current application does not include wherein the acceptance point device reads an update indicator on the portable device (token), as recited in claim 25 of 11/923,958. However it would have been obvious to one of ordinary skill in the art at the time of the invention to read or determine update indicator before sending a message to change the status of the device in order to verify whether the device can be updated or changed.

Claims 59-63 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 35-41 of copending Application No. 11,923,958. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other. For example claim 59 of the current application does not recite wherein the portable device (phone) includes an update indicator, as recited in claim 35 of 11/923,958. However it would have been obvious to one of ordinary skill in the art at the time of the invention for the portable device to include update indicator to allow a device to verify whether the portable device can be updated or changed.

This is a provisional obviousness-type double patenting rejection.

Claims 1, 4-7 9-20, 43, 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-39 of copending

Application No. 12,561,678. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other. For example claim 1 of the current application does not recite receiving the token image if the remote host determines that the portable token is to be updated, as recited in claim 25 of 12,561,678. However it would have been obvious to one of ordinary skill in the art at the time of the invention for a host to determine if the portable device can be updated or changed for verification and documentation purpose.

Claims 39-42, 46-, 48-58 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 40-44 of copending Application No. 12,561,678. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other. For example claim 39 of the current application does not recite a host determines that the portable token requires updating, as recited in claim 40 of 12,561,678. However it would have been obvious to one of ordinary skill in the art at the time of the invention for a host to determine if the portable device can be updated or changed for verification and documentation purpose.

Claims 39-42 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 40-44 of copending Application No. 12,561,678. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other. For example claim 39 of the current application recites the token acceptance device including means for a request using a keypad or a graphical user interface to update the portable device. However it would have been obvious to one of ordinary skill in the art at the time of the invention to provide means for

requesting update portable device in order for the portable token holder to directly request the update of the portable device for convenience purpose.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

Applicant's arguments with respect to claims 1, 4-7, 9-20, 35-43, 45, 46, 48-51, 55-63 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622